

Application No. 10/078,816 2 of 4
Reply dated 24 August 2004
Responsive to Office Action mailed on 28 May 2004

REMARKS

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, 4 through 12, and 14 through 20 were rejected under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,515,194 to Ncading *et al.* These rejections are hereby respectfully traversed on the ground that it was not shown in the Office Action that the cited reference teaches every element of any of the rejected claims.

Each of the three independent Claims 1, 10, and 17 reads that the dehydration indicator is "adapted to measure a urine ionic strength correlated to a specific gravity of a wearer's urine and provide a visible signal when the urine ionic strength reaches a value corresponding to a predetermined threshold of the specific gravity". All of the other rejected claims depend from these three independent claims and thereby also contain these limitations.

On the other hand, the cited reference fails to mention the measurement of any property. The reference also fails to mention an ionic strength of any substance. Subsequently, the characterization in the Office Action that the reference discloses a "dehydration indicator 14A, 16...adapted to measure the ionic strength and specific gravity of urine" is not accurate. In addition, the reference fails to mention the correlation of any other property to specific gravity. The reference also fails to mention predetermining, *i.e.*, selecting ahead of time, a threshold value of any property. Finally, the reference fails to mention providing a visible signal when such a measured ionic strength reaches a value corresponding to such a predetermined threshold of a correlated property.

In fact, the reference fails to mention anything in common with any of the quoted limitations contained in the rejected independent claims, except for the term "specific gravity". Furthermore, the solitary mention of "specific gravity" occurs in the sentence disclosing that "[t]he color change or like response of the material of the peripheral edge 14A can be elicited by wetness, pH, temperature, specific gravity" or any of seventeen substances listed immediately thereafter or "any antibody or reagent specific to biological metabolites or hormones". In other words, the only place where "specific gravity" is mentioned is in a "laundry list" of an indefinite number of properties and substances by which the visible response can be "elicited".

Additionally, the following points in this section of the Office Action bear comment.

Application No. 10/078,816 3 of 4
Reply dated 24 August 2004
Responsive to Office Action mailed on 28 May 2004

In the Office Action, Claims 2, 3, and 13 were referenced in the context of a qualitative indication of specific gravity. However, Claims 3 and 13 do not contain such an element. Furthermore, the cited reference discloses merely a wetness indicator that indicates nothing more than a change from a dry state to a wet state and therefore does not anticipate the limitation of Claim 2.

With respect to Claim 5, 6, 19, and 20, an indicium is a distinctive mark. A color change is not an indicium, but a chemical reaction.

With respect to Claims 8 and 14, element 14B in the cited reference is not a semi-permeable membrane. It is the central portion 14B of the fluid transport layer 14. Furthermore, the indicator 16 is located in the peripheral edge 14A of the fluid transport layer 14 (column 3, lines 57-60; Figures 1, 3), not in the central portion 14B, which is "spaced inwardly from the peripheral edge 14A" (column 3, lines 33-35; Figures 1, 3, 5, 6, 7).

In summary with regard to these rejections, the cited Neading *et al.* reference fails to teach every element of any of the rejected claims. Accordingly, it is respectfully requested that the rejections of Claims 1, 2, 4 through 12, and 14 through 20 under 35 USC § 102(c) be reconsidered and withdrawn.

Claim Rejections Under 35 U.S.C. § 103

Claims 3 and 13 were rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,515,194 to Neading *et al.* in view of U.S. Patent No. 5, 947,943 to Lee. These rejections are hereby respectfully traversed on the ground that it was not shown in the Office Action that the three requirements of MPEP 2143 for the establishment of a *prima facie* case of obviousness have been met.

As noted above, the Neading *et al.* reference fails to teach or suggest all of the limitations of independent Claims 1 and 10, from which Claims 3 and 13 respectively depend. The Lee reference likewise fails to teach or suggest any of the missing limitations and thus fails to remedy the shortcomings of the Neading *et al.* reference.

In addition, the modification proposed in the Office Action would defeat the expressly stated purpose of the inventors in the Neading *et al.* reference. The wetness indicator 16 of Neading *et al.* is exposed, i.e., not covered by any other layer, and is therefore visible at the peripheral edge 14A (column 2, lines 4 and 56; column 3, line 62; column 4, lines 45, 49, and 67; column 5, line 23; column 6, lines 6, 17, 23, and 29; Figures 1, 3). This exposure and visibility of the indicator "along substantially all portions of the

Application No. 10/078,816 4 of 4
Reply dated 24 August 2004
Responsive to Office Action mailed on 28 May 2004

peripheral edge" is a key feature of the invention (column 3, line 59 through column 4, line 1). Thus, to cover it up with any layer would defeat the inventors' purpose.

Furthermore, the Neading *et al.* reference explicitly teaches away from reapplying the structure taught by Lee, to wit "[t]he Lee patent, however, appears to be unduly complex and costly" (column 1, lines 45 and 46).

Therefore, the cited prior art references, either singly or in combination, fail to teach or suggest all of the limitations of the rejected claims. The references similarly fail to provide any suggestion or motivation to modify their teachings and, on the contrary, the Neading *et al.* reference explicitly teaches away from using the teachings of the Lee reference. Furthermore, the modification proposed in the Office Action would defeat the express purpose of the inventors in the Neading *et al.* reference.

Thus, none of the three requirements of MPEP 2143 for the establishment of a *prima facie* case of obviousness has been met with respect to either of the rejected claims. Accordingly, it is respectfully requested that the rejections of Claims 3 and 13 under 35 USC § 103(a) be reconsidered and withdrawn.

Summary of this Response

No new matter has been added in this response. In light of the above remarks, it is respectfully requested that the rejections be reconsidered and withdrawn and that the pending claims be allowed.

Respectfully submitted,

By: Michael P. Hayden

Michael P. Hayden

Registration No. 48,433

Phone: (513) 626-5800

Fax: (513) 626-3004 or 3499

24 August 2004

Customer No. 27752